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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/828,443	04/20/2004	Richard Baer	10030568-1	4008

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL 429
Intellectual Property Administration
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Loveland, CO 80537-0599

EXAMINER

KOZIOL, STEPHEN R

ART UNIT	PAPER NUMBER
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2624

MAIL DATE	DELIVERY MODE
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09/18/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/828,443

Applicant(s)

BAER, RICHARD

Examiner

Stephen R. Koziol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08/13/2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 15, 16, 29 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-28, 30, 32 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's arguments with respect to amended claims 1, 11, 26, and 30 have been considered but are moot in view of the new grounds of rejection. Claims 15, 16, 29 and 31 have been cancelled. The objection to claim 7 has been withdrawn.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims (1-14, 17, 18, 22-30, and 33) are rejected under 35 U.S.C. 102(b) as being anticipated by Janiak et al. US 2002/0030581 A1.

Regarding claim 1, Janiak discloses a biometric data card (fig 1 [16]), comprising: an image sensor for capturing an image of a biometric feature of a user of the biometric data card and producing first image data representing the image (fig 1 [16], also, par. [0027]); a memory operable to store second image data (fig 1 [16], also, par. [0027]); and a processor in communication with said image sensor and said memory, said processor operable to perform a comparison of the first image data with the second image data, and, to generate, in response to the comparison, authentication information representative of an authentication of the user (fig 1

[16], also, pars. [0027], [0039]) wherein the processor is configured for transmitting the authentication information through a card interface in a terminal so as to authenticate the user to the terminal separate from said image sensor, said memory, and said processor (Fig 1, also, par. 0027 where Janiak clearly states that the smart card (fig 1 item 16) is fully capable of acquiring, storing and processing biometric user data separate from and independent of the terminal (fig. 1 item 10) From par 0027: “[a]dditionally, the data card can be a smart card, where transactional data can be collected and stored, but it can also be processed and used directly by the smart card in particular applications. Therefore, a card that is read-only, read-and-write, or read-write-transactional is contemplated by data card 16.”

Regarding claim 11, Janiak discloses a terminal for authenticating a user of the terminal comprising: an optical interface configured to receive light reflected from a biometric feature of the user; an optical element optically coupled to said optical interface via an optical path, said optical element operable to form an image of the biometric feature from the reflected light and to direct the image onto an image sensor within the biometric data card (fig. 1 item 16, also pars. 0027 and 0039, where Janiak clearly states the biometric data card is fully capable of acquiring, storing and processing biometric user data separate from and independent of the terminal (fig. 1 item 10); and a card interface configured to receive a biometric data card and operable to authenticate the user based on the image and to provide an authentication signal to the terminal (fig.1, fig. 10 [36], also, par. [0036] & [0039]), and said card interface being optically coupled to said optical interface and said optical element to direct the image onto the image sensor within the biometric data card (fig. 1 item 16, also pars. 0027 and 0039, where Janiak clearly states the

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biometric data card is fully capable of acquiring, storing and processing biometric user data separate from and independent of the terminal (fig. 1 item 10) and that said biometric data card interface is optically coupled to said optical element From par 0027: “[t]his finger image data is capable of being optically read from the data card.”

Regarding claim 26 Janiak discloses a method for authenticating a user using a biometric data card (fig 12), the method comprising: capturing an image of a biometric feature of a user on an image sensor in the biometric data card (Fig 1, also, par. 0027 where Janiak clearly states that the smart card (fig 1 item 16) is fully capable of acquiring, storing and processing biometric user data separate from and independent of the terminal (fig. 1 item 10) From par 0027: “[a]dditionally, the data card can be a smart card, where transactional data can be collected and stored, but it can also be processed and used directly by the smart card in particular applications. Therefore, a card that is read-only, read-and-write, or read-write-transactional is contemplated by data card 16.”; producing in the biometric data card first biometric image data in response to ~~an~~ the image of a biometric feature of the user captured by said image sensor (see references above); comparing in said biometric data card the first biometric image data with second biometric image data; and authenticating the user in response to said comparing (fig 12, also, par. [0036] & [0039]).

Regarding claim 30, Janiak discloses the method of claim 29 26extracting first feature characteristics from the image data to produce the first biometric image data; the second biometric image data includes second feature characteristics extracted from a previous image;

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and said comparing includes comparing the first feature characteristics to the second feature characteristics (fig 12, also, par. [0036] & [0039]).

Regarding claims (2-10, 12-14, 17, 18, 22-25, 27, 28, and 33) the grounds for rejection are the same as set forth in the last Office Action.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: (*See MPEP Ch. 2141*)

- a. Determining the scope and contents of the prior art;
- b. Ascertaining the differences between the prior art and the claims in issue;
- c. Resolving the level of ordinary skill in the pertinent art; and
- d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.

5. Claims (19-21, and 32) are rejected under 35 U.S.C. 103(a) as being unpatentable over Janiak further in view of Angelo US 6,182,892 B1 for the same reasons as set forth in the last Office Action.

Response to Arguments

6. Applicant has amended claims (1, 11, 26, and 30) in an attempt to further define the subject matter at hand. The amendments to claims (1, 11, 26, and 30) do not relate to the statutory requirements of patentability.

Applicant's arguments filed August 13, 2007 have been fully considered but they are not persuasive.

With respect to independent claims (1, 11, 23, and 26) applicant alleges that Janiak's disclosed biometric data card does not contain a fingerprint sensor capable of capturing a biometric image within the card, and that the terminal and image sensor are part of the same device. Also, applicant alleges that Janiak teaches away from the present invention in that the biometric features are captured on an image sensor in a terminal, rather than in a data card.

With respect to claims 19-21 and 33, applicant alleges that Angelo discloses an optical path to transmit an image to a CCD array in a live scan device, and as such, teaches away from the present invention.

Examiner respectfully disagrees.

With respect to independent claims (1, 11, 23, and 26), Janiak clearly shows in Fig 1, also, par. 0027 that the smart card (fig 1 item 16) is fully capable of acquiring, storing and processing

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biometric user data separate from and independent of the terminal (fig. 1 item 10) From par 0027: “[a]dditionally, the data card can be a smart card, where transactional data can be collected and stored, but it can also be processed and used directly by the smart card in particular applications. Therefore, a card that is read-only, read-and-write, or read-write-transactional is contemplated by data card 16.” Furthermore, Examiner notes that a “teaches away” argument is moot with respect to a 35 U.S.C. §102 (b) anticipatory rejection. See MPEP 2131.04:

“Arguments that the alleged anticipatory prior art is nonanalogous art’ or teaches away from the invention’ or is not recognized as solving the problem solved by the claimed invention, [are] not germane’ to a rejection under section 102.” *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). See also *State Contracting & Eng’g Corp. v. Condotte America, Inc.*, 346 F.3d 1057, 1068, 68 USPQ2d 1481, 1488 (Fed. Cir. 2003). Therefore the original grounds for rejection of claims (1, 11, 23, and 26) under 35 U.S.C. §102(b) are maintained.

With respect to dependent claims (2-10, 12-14, 17, 18, 22, 24, 25, 27, 28, and 33) applicant does not raise further issue, and instead relies upon arguments re independent claims (1, 11, 23, and 26), which have been refuted above. Therefore the original grounds for rejection for dependent claims (2-10, 12-14, 17, 18, 22, 24, 25, 27, 28, and 33) are maintained.

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With respect to claims 19-21 and 32, secondary reference Angelo is used meet the limitations:

- Re claims 19 and 32 “an illumination source” (Angelo, fig 9 item 97, also, col. 6 ln. 36-41)
- Re claim 20 “a lens” (Angelo, col. 5 ln. 50-54)
- Re claim 21 “transfer optics” (Angelo col. 14, ln. 5-12).

Applicant does not challenge Examiner’s use of Angelo to meet the above limitations, but rather relies on previously stated arguments re claim 11, which have been refuted above. Therefore the original grounds for rejection of claims 19-21 and 32 under 35 USC 103 (a) are maintained.

For the reasons above, all 102 and 103 rejections as set forth in the last Office Action stand.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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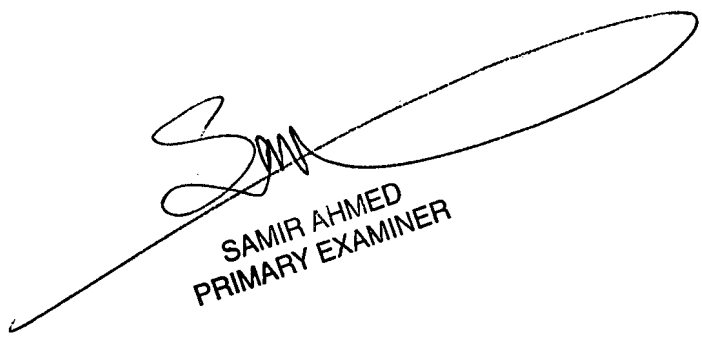
Contact

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steve Koziol whose telephone number is (571) 270-1884. The examiner can normally be reached on M - alt. F 8:00-5:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samir Ahmed can be reached at (571) 272-7413. Customer Service can be reached at (571) 272-2600. The fax number for the organization where this application or proceeding is assigned is (571) 273-7332.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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